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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,270	12/06/2001	Michael Skala	P-3767-US	3848
27130	7590	06/03/2004	EXAMINER	
EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020			PARSONS, CHARLES E	
			ART UNIT	PAPER NUMBER
			2613	7

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/004,270

Applicant(s)

SKALA ET AL.

Examiner

Charles E Parsons

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4.6</u> | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 9-14, and 18-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Alphano PN 6240312.

Claims 1,11,22,24,29,34,38: A method for observing an Image stream, the method comprising:

accepting images acquired by a vehicle disposed within a body lumen; (See Alphano Abstract as well as figure 10)

displaying the images on a monitor in the form of a moving image; (See Alphano figure 2 showing the video camera, therefore the image is a moving image, displayed on the display illustrated in figure 10 item C.

accepting a signal from a wheel; and (See figure 10, items C1 and C2 showing both the Mouse and the Joystick)

altering the display of the moving image according to the signal. (Clearly if the capsule is guided and the camera is attached to the capsule, the image displayed will inherently be altered. See abstract)

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Claims 2, 12, 25, 30, 35, 37: The method of claim 1, wherein moving the wheel a certain distance from a center point causes the moving image to be displayed at a certain speed. (All moving images are displayed at a certain speed usually 30 frames per second in the case of video images.)

Claims 3, 13, 21, 26,31,36: The method of claim 1, wherein moving the wheel/joystick a certain distance from a center point causes the moving image to be displayed in a certain direction. (See figure 10 items C1 and C2, movement of these control devices will cause the display to be altered because the view of the camera will change, See abstract.)

Claims 4, 5,14,20,23: The method of claim 1, wherein movement of a set distance of the wheel/ Joystick causes a different frame of the moving image to be displayed. (This is an inherent feature of moving images. Furthermore, as the controllers are moved and the video is running and different frame will be displayed.)

Claims 9,18, 27, 32: The method as in claim 1, wherein the vehicle is a capsule. (See figure 2)

Claims 10, 19, 33, 28: The method as in claim 1 wherein the images are images from a gastrointestinal tract. (See Figures 8 and 9 as well as column 4 line 34.)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 7,8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfano PN 6240312.

7, 16. The method of claim 1, wherein a signal is accepted through a scrolling wheel of a pointing device.

8, 17. The method of claim 1, wherein the wheel is a scrolling wheel.

(As for claims 7 and 8, note that Alphano uses a mouse, while Alfano does not specifically mention that his mouse has a scrolling wheel, at the time the invention was made, many mice had scrolling wheels that could be used for scrolling through images. Therefore it would have been obvious to one of ordinary skill in the art to use a mouse with a scrolling wheel. One would have been motivated to do so by the desire to scroll through a video one frame at a time in an efficient manner.) Official notice served

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The terms "can be, and certain speed and certain direction" in claims 2,3,6,12,13,15,21,25,26,30,31,35,36,37 are relative terms which render the claims indefinite. The term "certain and can be" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Furthermore the term "can be" does not indicate that the element is necessary to the invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Parsons whose telephone number is 703-305-3862. The examiner can normally be reached on M-TH 7AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CEP

  
GIMS PHILIPPE  
PRIMARY EXAMINER